

REMARKS/ARGUMENTS

Favorable consideration of this application in light of the following discussion is respectfully requested.

Claims 1-57 are pending in the application.

In the outstanding Office Action, Claims 1-57 were rejected under 35 U.S.C. § 112, first paragraph, Claims 1, 5, 6, 17, 20, 24, 25, 36, 38, 39, 43, 44 and 55 were rejected under 35 U.S.C. § 102(e) as being anticipated by Yamada (U.S. Patent No. 6,239,837 B1); Claims 19 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of Nakatani (U.S. Patent No. 5,063,459); Claims 2, 5, 6, 16, 21, 24, 25, 35, 40, 43, 44, and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of Wakui (U.S. Patent No. 5,742,339); Claims 7-9, 11-15, 26-28, 30-34, 45-47 and 49-53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yamada and Wakui applied to Claims 2, 21 and 40 above and further in view of Yoshiura et al. (U.S. Patent No. 5,854,693); Claims 3, 4, 22, 23, 41, and 42 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Yamada and Wakui as applied to Claims 2, 21, and 40 and further in view of well known prior art; Claims 18, 37, and 56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada in view of well known prior art; and Claims 10, 29, and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over combination of Yamada, Wakui and Yoshiura as applied to Claims 8, 27 and 46 above, and further in view of Ikegaya et al. (U.S. Patent No. 5,379,124).

Claims 1, 19, 20, 38, 39, and 57 recite that the claimed apparatus or device includes at least two storing means different in storing format from each other. Support for this amendment is found in Applicants' originally filed specification.¹ No new matter is added. With at least two storing formats, improved reliability and performance is achieved.

¹ Specification, page 18, lines 18-24; see also page 25, lines 1-21; Figures 7, 8, and 11.

Applicants acknowledge with appreciation the telephone interview between the Examiner and Applicants' representative on January 11, 2005. During the interview, support for the feature at least two storing means different in storing format from each other was identified in the originally filed specification, thus overcoming the rejection under 35 U.S.C. § 112, first paragraph, and permitting the Examiner to consider the merits of the invention as claimed.

Briefly recapitulating, amended Claim 1 is directed to an image data storing device, comprising: at least two storing means different in storing format from each other, each for storing image data input via inputting means; transfer control means for controlling transfer of the image data between the plurality of storing means; and checking means included in the transfer control means for determining whether or not storing means included in a destination, to which the image data should be transferred, has a capacity great enough to store the image data. Examples of the two claimed storing means are hard drive 75 and video memory 66. *The image storing device is configured to operate within a digital multifunction copier.* Independent Claims 19, 20, 38, 39, and 57 are directed to alternative embodiments of Applicants' copier memory management invention. The claimed inventions allow for more efficient copier memory management.²

Yamada discloses a multi-memory management system *configured for use in a camera*.³ In Yamada, there are two storing means, where one is a non-volatile semiconductor memory and the other is a sub-memory, both of which are semiconductor memories. Therefore, Yamada does not disclose or suggest at least two storing means different in storing format from each other as recited in Applicants' amended independent claims. Because Yamada does not disclose or suggest all the elements of independent Claims 1, 19, 20, 38, 39, and 57, Applicants submit the inventions defined by Claims 1, 19, 20, 38, 39, and 57, and all

² Specification, page 2, lines 7-16.

³ Yamada, column 6, line 32 – column 7, line 10

claims depending therefrom, are not anticipated by the asserted prior art for at least the reasons stated above.⁴

Applicants have also considered the cited Wakui, Nakatani, and Ikegaya references and submit these references do not cure the deficiencies of Yamada. Wakui, like Yamada, discloses a camera memory. Wakui, Nakatani, and Ikegaya each fail to disclose or suggest at least two storing means different in storing format from each other as recited in Applicants' independent claims. Like Yamada, each of these references disclose semiconductor memories.

Yoshiura discloses a copier with a semiconductor memory. However, like the previously described references, Yoshiura does not disclose or suggest at least two storing means different in storing format from each other as recited in Applicants' amended independent claims.

Furthermore, Applicants submit there is no teaching, suggestion, or motivation, either explicitly or implicitly, in either reference to combine the camera memories of Yamada or Wakui with the copier memory of Yoshiura to arrive at Applicants' inventions recited in Claims 1, 19, 20, 38, 39, and 57. Thus, Applicants submit it is only through an impermissible hindsight reconstruction of Applicants' invention that any rejection of Claims 1, 19, 20, 38, 39, and 57 based on this combination can be understood.⁵ Similarly, Applicants submit that the rejection of Applicants' claimed inventions in view of the combination of the camera memory of Yamada with the facsimile memory of Nakatani or Ikegaya is also based on improper hindsight reasoning.

⁴ MPEP § 2142 "...the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

⁵ MPEP § 2143.01 "Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge of one of ordinary skill in the art."

Applicants also submit that camera art of Yamada is not analogous to the facsimile art of Nakatani and Ikegaya or the copier art of Yoshiura and, thus, for another reason, rejections based on combinations of these references are based on improper hindsight reasoning.

Accordingly, in light of the previous discussion, Applicants respectfully submit that the present application is in condition for allowance and respectfully request an early and favorable action to that effect.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Gregory J. Maier
Attorney of Record
Registration No. 25,599
Michael E. Monaco
Registration No. 52,041

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
GJM/MEMO/kkn
I:\ATTY\MM\AMENDMENT\0557\202544.RESP DUE FEB. 28..DOC